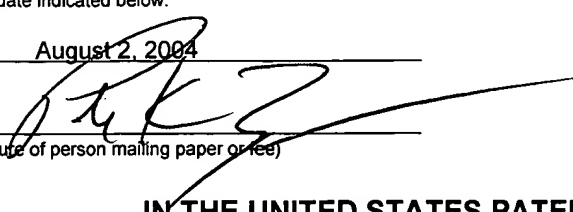


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PATENT

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Inventors	:	Charles Kormanik, Jr.
Serial No.	:	08/802,472
Filed	:	February 18, 1997
For	:	THEMATIC PACKAGING SYSTEM
Group Art Unit	:	3208
Examiner	:	Luby, M.

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**BRIEF ON APPEAL  
ON BEHALF OF APPELLANT**

## **TABLE OF CONTENTS**

Title Page	1
Certificate Under 37 C.F.R. §1.8(a)	1
Table of Contents	2
Table of Cited Decisions	3
Appeal Brief	4
Real Party in Interest	4
Related Appeals and Interferences	4
Status of All Claims	4
Status of All Amendments Filed Subsequent to Final Rejection	5
Concise Summary of the Invention	5
Reading of Claims on Specification	5
Concise Statement of All Issues Presented for Review	12
Grouping of Claims for Each Ground of Rejection Which Appellant Contests	13
Argument	13
Conclusion	68
Appendix	69

## TABLE OF CITED DECISIONS

<i>In re Bond</i> , 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)	14
<i>In re Reuter</i> , 651 F.2d 751, 210 U.S.P.Q. 249 (C.C.P.A. 1981).	35
<i>In re Oetiker</i> , 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)	35
<i>In re Bell</i> , 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting <i>In re Rinehart</i> , 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1976))	35
<i>In re Miller</i> , 418 F.2d 1392, 64 USPQ 46 (CCPA 1969).	35
<i>In re Fine</i> , 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).	35
<i>In re Clayton</i> , 205 USPQ 269 (PTO Bd of App. 1979)	36
<i>In re Jones</i> 21 USPQ2d 1941 (Fed. Cir. 1992)..	36
<i>In re Fine</i> , 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)	36
<i>In re Mills</i> , 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)	40
<i>Interconnect Planning Corp. v. Feil</i> , 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985)	39
<i>In re Lee</i> , 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002)	53
<i>In re Gordon</i>	54
<i>In re Miller</i> , 418 F.2d 1392, 64 USPQ 46 (CCPA 1969)	61
<i>In re Wood</i> , 599 F.2d 1032, 202 USPQ 171 (CCPA 1979)	66
<i>In re Horn</i> , 203 USPQ 969 (CCPA 1979)	66

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Examiner : Luby, M.

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Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

**BRIEF ON APPEAL  
ON BEHALF OF APPELLANT**

S I R :

This is an appeal from the Final Action of the Examiner dated 12 December 2003, rejecting claims 5, 9-15, 17-31, and 49-58 in this application.

Please charge the fee under 37 C.F.R. § 1.17, the fee for Extension of Time for filing of this Brief, and any other fee necessary for filing this Brief on Appeal, or for further prosecution, to Deposit Account No. 50-0235.

**II. Real Party In Interest**

Appellant, Charles Kormanik, is the real party in interest in this matter.

**III. Related Appeals and Interferences**

This is the second appeal in this case, the first being Appeal No. 2001-2537.

**IV. Status of All Claims**

Claims 5, 9-15, 17-31, and 49-58 have been rejected. Claims 24-26 have been

allowed. Claims 19, 21, 27, 50, 52, 54, 56, and 58 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**V. Status of All Amendments Filed Subsequent to Final Rejection**

Subsequent to the Final Rejection, on March 3, 2004, an Amendment was filed pursuant to which the Examiner has withdrawn all §112 rejections. A second Amendment filed July 27, 2004, addressed a previously unnoticed §112 issue, i.e., incorrectly numbered claims, and the amendment was entered by telephone agreement with the Examiner. There remains no objection related the drawings, and no rejection based on Sec. 112.

**VI. Concise Summary of the Invention**

The invention is directed to a method for making a combination of thematic packaging and an article contained therein to facilitate marketing the combination. The method includes constructing the package as a replica of a recognizable icon, the shape of the package being visually suggestive of an activity associated with an icon in which the article is used during the activity, after removal from the package.

As an example, the thematically packaging could be in the shape of a golf ball as an icon, which is visually suggestive of the activity "playing golf," and the article contained in the golf-ball-shaped packaging could be a rain poncho, which after removal from the packaging, is used in playing golf, e.g., in the rain.

**VII. Reading of Claims on the Specification**

The claims on Appeal read on the specification as follows:

Claims 1-4 (canceled)

5. A method for making a combination of a thematic package and an article contained in the package for combined marketing, the method including the steps of: form a combination...packaging. Pg14, Ln1-5

constructing the package as a replica of a recognizable icon, the package having a shape that is different than any shape to be contained therein,

the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package,

the package having a hollow interior;

locating the article within the hollow interior of the package to form the combination of the article and the thematically-shaped package; and

marketing the combination.

Claims 6-7 (canceled)

8. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a golf ball as the icon, and wherein the activity is a game of golf.

9. The method of claim 5, wherein the step of constructing includes: constructing the replica as a baseball as the icon, and wherein the activity is a game of baseball.

10. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a life preserver as the icon, and wherein the activity is a race.

11. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a football as the icon, and wherein the activity is a game of football.

12. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a

shape...or suggestive. Pg13, Ln3-4

symbol...suggestive of an activity Pg13, Ln8-9

...having a hollow... Pg4, Ln18

locating...within the packaging. Pg4, Ln22

three...packaging 52...in a...box 54. Pg12, Ln26-28

packaging ... golf ball. Pg12, Ln13

packaging ... baseballs Pg13, Ln29

life preserver Pg13, Ln22

packaging ... footballs Pg13, Ln29

packaging ... tennis balls Pg13, Ln29

tennis ball as the icon, and wherein the activity is a game of tennis.

13. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a ball, and wherein the activity is a game in which the ball is used.

baseballs..., etc. Pg13, Ln29-30

14. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a wheel as the icon, and wherein the activity is a race.

three dimensional ... card...packaging Pg14, Ln12-15

15. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a charge or bank card as the icon, and wherein the activity includes use of the card.

Visa...American Express Pg14, Ln13-14

16. (canceled)

17. The method of claim 5, further including the step of locating a logo on the package.

Three...packaging 52...in a...box 54. Pg12, Ln26-28

18. The method of claim 5, further including the step of: adding an outer layer of packaging to the combination, the outer layer of packaging shaped to visually suggest the associated activity.

"sleeve" of golf balls. Pg12, Ln29

19. The method of claim 18, wherein the outer layer includes a sleeve for golf balls.

"sleeve" of golf balls. Pg12, Ln29

20. (previously amended) The method of claim 5, wherein the step of constructing further includes the step of:

constructing the package to have additional utility independent from containing said article.

packaging...independent utility Pg15, Ln10-12; golf related purpose p15, l5

21. The method of claim 19, wherein the step of constructing further includes the step of:

constructing the package to be a toy after said removal of said article.

toy/or...Pg15, Ln13

22. The method of claim 20, wherein the step of constructing the package to have additional utility includes constructing the package out of a substance capable of receiving subsequent writing from a pen or magic marker.

receive writing...Pg12, Ln23-24

23. The method of claim 5, wherein the step of constructing includes securing to an exterior part of the package a means for attaching the package to another article.

ring, tab, fixture...attaching the packaging to another article. Pg15, Ln14-17

24. A method for making a combination of thematic packaging and an article contained in the thematic packaging, the method including the steps of:

forming the combination by providing the article in the package,

item inside the package Pg15, Ln23

the package being shaped like a particular ball to visually suggest a particular sport activity associated with said ball, the package being openable to remove the article,

packaging is shaped as a golf ball. p15, l22

the object being a member of the group of rain gear consisting of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat, and a seat cover,

rain...seat cover Pg12, Ln31-32

the member being useful during the activity wherein the package is openable to remove the article for use of the object while engaged in the associated activity.

protective sleeve 2 can be located in thematic packaging. Pg12, Ln10-11; two hemispheric halves...joinable...encase protective sleeve 2. p12, l17-21

25. A method for making a combination of thematically-shaped packaging for a thematically associated article contained therein, the method including the steps of:

shape...or suggestive. Pg13, Ln3-4

constructing a package having a shape that is a recognizable icon visually

symbol...suggestive of an activity Pg13, Ln8-9



suggestive of an activity associated with the icon,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the package,

the article having a use in the associated activity, to form the combination of the article and the thematically-shaped packaging; and wherein the step of constructing further includes the step of:

constructing the package as a replica of a golf ball to visually suggest the activity of a game of golf; and wherein the step of locating the article within the packaging further includes the step of:

locating rain gear, as the article, within the hollow interior of the replica such that the rain gear is removable for the use during, and visually associated for use in, the activity of playing the game of golf in the rain.

26. A method of making a combination of thematically-shaped packaging and an article contained therein, the method including the steps of:

constructing the package as a replica of a symbol having a shape that visually suggests an activity associated with the symbol,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the packaging,

the article having a use in the associated activity,

to form the combination of the article and the thematically-shaped packaging;

...having a hollow...Pg4, Ln18

locating...within the packaging. Pg4, Ln22

...golf related purpose...Pg15, Ln5

thematic packaging resembles a golf ball. Pg12, Ln13

golf related...suggestive of their use. Pg13, Ln1-3

form a combination...packaging. Pg14, Ln1-5

shape...or suggestive.... Pg13, Ln3-4

...having a hollow...Pg4, Ln18

locating...within the packaging. Pg4, Ln22

golf related...suggestive of their use. Pg13, Ln1-3

form a combination...packaging. Pg14, Ln1-5

and wherein the step of constructing further includes the step of:

constructing the package as a replica of a baseball to visually suggest the associated activity of a baseball game;

and wherein the step of locating the article within the package further includes the step of:

locating rain gear, as the article, within the packaging such that the rain gear is removable for the use during, and visually associated with, the associated activity of watching the baseball game in the rain.

27. The method of any one claims 5 and 8-23, wherein the step of locating is carried out with rain gear as the article.

28. The method of any one of claims 5 and 8-23, further including the steps of:

locating another article within the hollow, the other article having a use during the activity, after removal from the package.

29. The method of any one claims 5 and 8-23, wherein the step of constructing includes constructing the replica out of plastic and the article out of plastic.

30. The method of claim 5, wherein the step of constructing is carried out with the activity being a sport activity.

31. The method of claim 5, wherein the step of constructing includes constructing the package as having separably joinable pieces, the pieces being joinable to form the hollow interior of the package and being separably to open the package for the removal of the article.

49. The method of claim 5, wherein the step of constructing includes

baseballs...sporting events Pg14, Ln29-30

locating...within the packaging. Pg4, Ln22

symbol...suggestive of an activity Pg13, Ln8-9

locating...within the packaging. Pg4, Ln22

locating...within the packaging. Pg4, Ln22

joinable by interior lip 58 that engages exterior lip 60 when the halves are pushed together...Pg12, Ln19-20

constructing a plastic replica of a golf ball...Pg4, Ln19-20

protective sleeve...made...of plastic. Pg9, Ln4-5

joinable by interior lip 58 that engages exterior lip 60 when the halves are pushed together...Pg12, Ln19-20

the step of imprinting a message on the package, the message being suggestive of the use of the article.

50. The method of claim 27, wherein the step of constructing includes constructing the package as having separably joinable pieces, the pieces being joinable to form the hallow interior of the package and being separably to open the package for the removal of the article.

51. A method for making more than one combination of a thematic package and article respectively contained therein for combined marketing, the method including the steps of:

constructing the packages as respective replicas of at least one recognizable icon, one of the packages having a shape that is different than any shape to be contained therein,

each said package having a shape visually suggestive of an activity associated with said at least one icon in which the respective article is used during the activity, after removal from the package, and

each said package having a hallow interior;

locating the respective articles within the respective hallow interiors of the respective packages to form the more than one combination of the articles and the thematic packages; and

marketing the more than one combination.

52. The method of claim 34, wherein:

the step of constructing the packages to replicate the at least one recognizable icon is carried out with each said at least one recognizable icon being a golf ball; and further including the step of

three...packaging 52...in a...box 54. Pg12, Ln26-28

joinable by interior lip 58 that engages exterior lip 60 when the halves are pushed together...Pg12, Ln19-20

three...packaging 52...in a...box 54. Pg12, Ln26-28

constructing a plastic replica of a golf ball...Pg4, Ln19-20

golf related...suggestive of their use. Pg13, Ln1-3

...having a hollow...Pg4, Ln18

locating...within the packaging. Pg4, Ln22

three...packaging 52...in a...box 54. Pg12, Ln26-28

constructing a plastic replica of a golf ball...Pg4, Ln19-20

packaging the more than one combination in a box having the appearance of a sleeve for golf balls to permit carrying out of said step of marketing the more than one combination.

three...packaging 52...in a...box 54. Pg12, Ln26-28

53. The method of claim 34, wherein the step of marketing the more than one combination is carried out with the respective packages resembling balls and with a box therefore.

constructing a plastic replica of a golf ball...Pg4, Ln19-20  
three...packaging 52...in a...box 54. Pg12, Ln26-28

54. The method of claim 34, wherein the step of locating is carried out with the articles respectively being different kinds of rain gear.

locating...within the packaging. Pg4, Ln22  
rain...seat cover Pg12, Ln31-32

55. The method of claim 34, wherein the step of locating is carried out with the articles respectively being different kinds of articles.

locating...within the packaging. Pg4, Ln22  
rain...seat cover Pg12, Ln31-32

56. The method of claim 38, wherein the step of locating is carried out with one of the kinds of articles including rain gear.

locating...within the packaging. Pg4, Ln22  
rain...seat cover Pg12, Ln31-32

57. The method of claim 34, wherein the step of constructing the packages includes constructing the packages to respectively resemble a variety of balls.

constructing a plastic replica of a golf ball...Pg4, Ln19-20

58. The method of any one claims 5 and 8-23, wherein the step of locating is carried out with the article from a group consisting of sun screen, a band-aide, a golf tee, ball mark, insect repellent, and bee sting treatment.

... insect repellent, bee sting treatment, etc...  
Pg. 5, Lns. 25-32

#### **VIII. Concise Statement of All Issues Presented for Review**

As stated hereinabove, all §112 rejections have been overcome.

A. Pursuant to 35 §U.S.C. 102(b), are claims 5, 9, 11, 22, 28, 30, and 31 anticipated by U.S. Patent No. 3,624,939 (Gossard)?

B. Pursuant to 35 §U.S.C. 103(a), are claims 8, 12, 14, 15, 18, 29, 51, 53, 55, and 57 obvious in view of Gossard?

C. Pursuant to 35 §U.S.C. 103(a), are claims 17 and 49 obvious over Gossard in view of Des. Pat. 346,185 (Francis)?

D. Pursuant to 35 §U.S.C. 103(a), is claim 23 obvious over Gossard in view of Des. Pat. 196,679 (Schaffer)?

**IX. Grouping of Claims for Each Ground of Rejection Which Appellant Contests**

The claims of any group do not stand or fall together, and indeed stand separately, and the respective arguments appear below.

**X. Argument**

**A. Pursuant to 35 §U.S.C. 102(b), are claims 5, 9, 11, 22, 28, 30, and 31 anticipated by U.S. Patent No. 3,624,939 (Gossard)?**

**1. Legal Standard**

The legal standard for determining anticipation pursuant to 35 U.S.C. § 102 was stated in Structural Rubber Prod. Co. v. Park Rubber Co., 749 F.2d 707, 223 USPO 1264 (Fed. Cir. 1984)

"Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. Anticipation is not shown even if ...the differences between the claims and the prior art references are "insubstantial" and the missing elements could be supplied by the knowledge of one skilled in the art."

and In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990):

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

**2. Cited Art: Gossard**

U.S. Patent No. 3,624,939 (Gossard) is titled "Novelty Container for Photographs."

Gossard teaches "a container which is shaped to identify a particular sport... wherein photographs (of... players)... are removably mounted within the container." Col. 1, lines 20-26.

The “container... includes two hollow hemispherical sections 11 and 12 connected by an over-center spring hinge.” Col. 2, lines 61-64. Gossard is silent as to anything being done with the photographs after removal from the container, and Gossard shows photographs, but does not mention the activities of collecting sports memorabilia or collecting signatures.

3. **As to claims 5 (and 51 and all claims depending therefrom), the cited art does not teach the claimed method step of constructing... the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package.**

- a. **Claim 5**

- i. **Overview**

Claim 5 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action, and the Examiner relies on Gossard.

- ii. **Critique of Examiner’s Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). Gossard does not mention or suggest the claimed method step of:

constructing ... the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package....

As an overview, it is respectfully submitted that the Examiner has set forth different theories of anticipation for individual claim requirements that do not make sense when all of the claim requirements are considered as a whole.

This pick and choose approach involves the Examiner stretching a “sports activity” into the cavity of “collecting signatures,” and is further obscured by Examiner

interpretation used to replace teachings in the cited reference, as is more particularly set out below.

**1.     ... activity associated with the icon...**

As to the claim requirement of constructing... a package visually suggestive of the activity associated with the icon..., what is the icon and the activity alleged in the rejection?

The answer is not clear. The Final Rejection at page 3, the Examiner states:

“the activity is a sport activity (*here interpreted to be the activity of collecting sports memorabilia including signatures on photographs of athletes which includes the subject of sporting events including the games of baseball, football, and soccer*)...

(Italics added).

From this passage, it is not clear whether the alleged activity is “a sport activity,” “collecting sports memorabilia,” or “collecting... signatures on photographs.” These are not the same activities, and each of these is addressed separately below.

**a.     First Examiner Theory**

As to the Examiner’s first theory, that the activity is “a sport activity,” Gossard teaches that the “invention concerns a container which is shaped to identify a particular sport, for example, baseball, football...” (Col. 1, lines 20-22). Accordingly, Applicant agrees that a baseball is an icon such that in Fig. 1 of Gossard shows a package visually suggestive of the activity associated with the icon, wherein the activity is playing baseball. A parallel situation exists with the football in Gossard’s Figure 5, the hockey puck in Figure 7, and the basketball of Figure 10 and the soccer ball of Figure 11. Under this first Examiner theory, Applicant agrees that these balls are respective teachings of icons that are suggestive of the respective particular sports activities. However, the Examiner stretches this teaching into different activities that are not taught by Gossard, as discussed below.

**b.     Second Examiner Theory**

The second Examiner theory is that Gossard teaches a package visually suggestive of the activity of "collecting sports memorabilia," as the Examiner has *interpreted* (see the above-quoted contention of the Examiner). "Collecting sports memorabilia" is not the same activity as the sport activity itself.

Further, the Examiner's *interpreted* view is explicitly contradicted by Gossard. Gossard teaches that the "invention concerns a container which is shaped to identify a particular sport, for example, baseball, football..." (Col. 1, lines 20-22). "Collecting sports memorabilia" is not a sport, as contemplated by Gossard. Other than the possibility of the Gossard photographs being interpreted as a specie of sports memorabilia (addressed below), Gossard does not mention or suggest the activity of "collecting sports memorabilia." The Examiner has *interpreted* with hindsight because there is no anticipatory teaching of "collecting sports memorabilia" mentioned in Gossard, and indeed, this interpretation is contrary to the genus of "sport" contemplated by Gossard. This Gossard contradicted interpretation by the Examiner is not what was required in In re Bond: "every element of the claimed invention must be identically shown in a single reference...."

### **c. Third Examiner Theory**

The third theory is that Gossard teaches a package visually suggestive of the activity of "collecting... signatures on photographs." "Collecting... signatures" is a different activity than the activity of the sport itself, and is also a different activity than the activity of "collecting... signatures." These are all distinct activities.

As to this third Examiner theory, it is respectfully submitted that the balls shown in the Figures of Gossard are not suggestive of "collecting... signatures on photographs." No one would imagine the activity of collecting signatures from the ball-shaped containers of Gossard, except an Examiner thinking in hindsight. That is, collecting signatures from athletes may be suggested by the photographs, but not from the shape of the Gossard container.



Nothing in Gossard teaches “collecting... signatures on photographs of athletes,” and this is not a ‘sport’ within the explicit teaching of Gossard. This is mere Examiner speculation, not an anticipatory teaching under In re Bond. Thus, under the third Examiner theory, there is no teaching of a package visually suggestive of the activity of “collecting... signatures on photographs.”

In sum, the claim requirement of a package visually suggestive of the activity associated with the icon... is disclosed under the first Examiner theory, but not under the other theories, though they are considered further below in the context of other claim requirements.

**2. ...the article is used during the activity after removal...**

Let us now consider the Examiner’s three theories under a further requirement of the claim as a whole, namely that the article in the package is used during the activity after removal.

Under the Examiner’s first theory, the rejection is defective because Gossard does not teach that the article (Gossard’s photograph) is used during the activity, i.e., *the sport activity*, e.g., baseball, football, etc. That is, Gossard does not teach, nor can one imagine, removing a photograph from Gossard’s container to use in shooting free-throws while playing basketball, for example. The Examiner’s first theory does not meet the claim requirements as a whole, and thus there is no anticipation. See In re Bond: “every element of the claimed invention must be identically shown in a single reference....”

Under the Examiner’s second theory, the rejection is also defective because Gossard does not teach that the article (Gossard’s photograph) is used during the activity of “collecting sports memorabilia”. That is, if the activity were “collecting sports memorabilia,” then as per the claim, the article (Gossard’s photograph) would have to be used during the activity of “collecting sports memorabilia.” But the photograph has no apparent use during the activity of

collecting—the photograph might be that which is collected, but it is not disclosed as used during the activity of collecting sports memorabilia as the Examiner contends. And if the photograph itself were being collected, it would not be collected after removal from the package because one would already have collected it in order for it to be in the package in the first place. Gossard is completely silent on any use of the photograph after removal. Any utility of the photograph after removal is Examiner speculation, not anticipatory evidence. Thus, the Gossard teaching is insufficient to anticipate the claim requirements. See In re Bond: “every element of the claimed invention must be identically shown in a single reference....”

As to the Examiner’s third theory, it has already been shown above that the figures in Gossard are not visually suggestive of collecting signatures. And as discussed above with regard to the Examiner’s second theory, even if one were to play out the third theory, the Examiner is just speculating that the signatures would be obtained on the photograph after removal, e.g, rather than before.

Therefore, under all the Examiner’s theories, there is no showing sufficient to meet the requirements of Sec. 102 as a whole, wherein as per In re Bond: “every element of the claimed invention must be identically shown in a single reference....”

**3. ...making a combination... for combined marketing**

Though already there is no anticipation as set out above, consider further claim requirements. Gossard is silent as to ...making a combination... for combined marketing and the claimed marketing step. Gossard seems to disclose a container provided for holding the photographs, not ...making a combination... for combined marketing. The Examiner is also silent as to this deficiency in the anticipation rejection, and the rejection is per se defective for this reason too.

It is respectfully submitted that this deficiency reflects a more profound problem

with the anticipation and obviousness rejections: the Examiner is attempting to reject method claims via apparatus art. The cited art is "shot in the dark" products without discovery of the reason for the claimed process steps. Thus, the rejections are premised on how the evidence is "*interpreted*" by the Examiner (in the Examiner's words at page 3 of the Final Rejection). The Examiner is just making up things about Gossard, like how and when the Gossard photographs are used, e.g., after removal, and Gossard didn't teach ...making a combination... for combined marketing. This is all Examiner speculation, not what was required by Sec. 102 and In re Bond.

#### **4. Conclusion**

Pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

Gossard does not identically show the method step of:

constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package

or

...making a combination... for combined marketing

and especially not both. Therefore, as per the prior Board Decision, "the examiner has not presented sufficient evidence from the prior art of the totality of the claim was suggested to an ordinary artisan, and thus there is no statutory anticipation."

(Additionally, with no teaching or suggestion thereof, no combination of cited art can render the claims obvious, either, as discussed below. This is determinative of all claim rejections, as discussed further herein, as there is a parallel to other independent claim requirements, and this argument is to be incorporated by reference in the rejection of each of the claims.)

#### **b. Claim 9**

##### **i. Overview**

Claim 9 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 9 adds the further claim requirement that wherein the activity is a game of baseball, which is not shown in connection with the other claim requirements.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., the activity is a game of baseball, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures) , after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 9, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the activity of a game of baseball by

somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during any game of baseball after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing. Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

**c. Claim 11**

**i. Overview**

Claim 11 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 11 adds the claim requirement that wherein the activity is a game of football, which additionally is not shown in connection with the other claim requirements.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., the activity is a

game of football, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures) , after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 11, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the activity of a game of football by somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during any game of football after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing. Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

#### **4. Claim 13**

##### **i. Overview**

Claim 13 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

##### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 13 adds the claim requirement that wherein the activity is a game in which the ball is used, which additionally is not shown in connection with the other claim requirements.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., the activity is a game in which the ball is used, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures) , after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 13, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the activity of a sport activity by somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during

any game of in which the ball is used after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing. Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

## **5. Claim 20**

### **i. Overview**

Claim 20 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 20 adds the claim requirement of constructing the package to have additional utility independent from containing said article, which additionally is not shown in connection with the other claim requirements.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., a sport activity, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia



or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures), after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 20, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the activity of a game by somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during any sport activity after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

Gossard is equally silent with regard to the claim requirement of constructing the package to have additional utility independent from containing said article. The Examiner contends that Gossard teaches constructing the package to have additional utility of "a toy (a ball to be played with or a paperweight)." Page 4 of the Office Action. But Gossard does not mention any contemplated additional utility independent from containing said article, a toy, or a paperweight. The idea of constructing Gossard to serve as a toy or as a paperweight comes only from the Examiner, and this is an Examiner "teaching," not a Gossard teaching.

Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed

invention must be identically shown in a single reference...."

**6. Claim 22**

**i. Overview**

Claim 22 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 22 adds the method step requirement of constructing the package out of a substance capable of receiving subsequent writing from a pen or magic marker, which additionally is not shown in connection with the other claim requirements.

There is no mention in Gossard of using the Gossard article (photograph) during any sport activity after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., a sport activity, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might

be used during the activity (of collecting memorabilia or signatures) , after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 22, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the activity of a sport activity by somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during any sport activity after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

Gossard is equally silent with regard to the claim requirement of constructing the package out of a substance capable of receiving subsequent writing from a pen or magic marker. The Examiner contends that such is disclosed in Figures 1-6 and 12. Page 4 of the Office Action.

The figures do not disclose any substance whatsoever, let alone a substance capable of receiving subsequent writing from a pen or magic marker. The text is equally silent. Gossard does not disclose any substance whatsoever, let alone one that is capable of performing the claimed function, and thus *Hutchison* does not apply. Nothing on Gossard teaches a method step involving a substance capable of receiving subsequent writing from a pen or magic marker, and thus there is no statutory anticipation. The idea of constructing Gossard out of one substance or another comes only from the Examiner, and this is an

Examiner "teaching," not a Gossard teaching.

Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

## **7. Claim 28**

### **i. Overview**

Claim 28 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 22 adds the method step requirement of locating another article within the hallow, the other article having a use during the activity, after removal from the package.

The Examiner offers no explanation for the rejection, but because there are two affirmative recitals of use, Gossard must somehow show a respective use. The rejection offers no explanation or reasoning and Applicant respectfully has no idea what the Examiner is referring to.

As best as can be determined from the Final Rejection, consistent with other rejections, perhaps the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the

icon, i.e., a sport activity, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures), after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 28, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the sport activity by somehow using the articles after they are removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during any sport activity after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

Gossard is equally silent with regard to the claim requirement of locating another article within the hallow, the other article having a use during the activity, after removal from the package. While Gossard mentions photographs, Gossard does not mention any contemplated other article having a use during the activity, after removal from the package. This idea, though not clear what it is, only from the Examiner, and this is an Examiner “teaching,” not a Gossard teaching.

Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e.,

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

## **8. Claim 30**

### **i. Overview**

Claim 30 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference. More so, claim 30 adds the method step requirement that the constructing is carried out with the activity being a sport activity, and this added requirement is not shown in connection with the other claim requirements for the reasons set out in claim 5.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., a sport activity, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures) , after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 30, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during a sport activity by somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during a sport activity after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

## **9. Claim 31**

### **i. Overview**

Claim 31 has been rejected pursuant to 35 U.S.C. Sec. 102. Examiner contentions are set forth in paragraph 9 of the Office Action.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 102 and In re Bond, because every element of the claimed invention is not identically shown in a single reference (Gossard). For example, Gossard does not teach the method step of constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package, as per the discussion above concerning claim 5, incorporated here by reference.

More so, claim 31 adds the method step requirement of constructing... the pieces being... separable to open the package..., which additionally is not shown in connection with the other claim requirements.

There is no mention in Gossard of using the Gossard article (photograph) during any sport activity after removal from the package. Gossard is completely silent on any use of the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

As best as can be determined from the Final Rejection, it seems that the Examiner is using the first Examiner theory to meet the part of the claim that requires the shape of the package visually suggestive of an activity associated with the icon, i.e., a sport activity, and then switching to the second or third theories for different activities that do not meet the activity associated with the icon requirement, i.e., that the activity now is collecting memorabilia or signatures. The change in theories is needed so that the article (Gossard photograph) might be used during the activity (of collecting memorabilia or signatures) after removal from the package. Next the Examiner skips the ...making a combination... for combined marketing claim requirement.

Applicant apologizes if the contention in the rejection is a bit difficult to follow, but this flows from the changing theories underpinning the rejections. Nonetheless, even if we forgive the change in theories, the contention still makes no sense: If this claim 5 interpretation were played out in claim 31, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia or signatures during the activity of a game of football by somehow using the photograph after it is removed from the packaging from whence it was first marketed as a combination.

There is no mention in Gossard of using the Gossard article (photograph) during any sport activity after removal from the package. Gossard is completely silent on any use of



the photograph after removal. Any timing and use is mere Examiner speculation, not an anticipatory showing.

Gossard is equally silent with regard to the claim requirement of constructing... the pieces being... separable to open the package.... The Examiner makes no particular contention about claim 31, and Applicant has no idea what the Examiner is referring to. Actually, Gossard explicitly contradicts the rejection: the Gossard the figures show, and the text specifies, the exact opposite of the claim requirement. Gossard teaches that pieces "11 and 12 are connected by an overcenter spring hinge 13." See Col. 1, lines 64-65. Contrast Gossard with the figures of the instant application, where the halves of a plastic ball are shown as claimed: separable to open the package.... Gossard's "connected" is not the claimed separable. Thus, Gossard does not teach the claim step, and thus there is no statutory anticipation.

Thus, the Gossard teaching is insufficient to anticipate the claim requirements. Thus, Gossard does not evidence statutory anticipation under Sec. 102 and In re Bond, i.e., "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

## **10. Summary**

The MPEP Sec. 2131 provides that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. ' *Verdicaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be found in as complete detail as contained in the ...claim." *Richardson v Suzuki Motor Co.*, 969 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required in the claim."

And as per In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990): "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...." Gossard does not teach the

claimed shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package and the claimed ...making a combination... for combined marketing. Accordingly, the Examiner has not presented sufficient evidence from the prior art of the totality of the claim was suggested to an ordinary artisan. Therefore, the rejections should again be reversed.

**B. 35 U.S.C. § 103**

**1. Legal Standard**

The legal standard for determining obviousness pursuant to 35 U.S.C. § 103 includes three factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The U.S. Supreme Court held that in applying Section 103, "the scope of the prior art is to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the art is to be ascertained." *Deere* at 17. Accordingly, the C.C.P.A. has ruled that 35 U.S.C. § 103 places the burden on the PTO to establish obviousness. *In re Reuter*, 651 F.2d 751, 210 U.S.P.Q. 249 (C.C.P.A. 1981).

In rejecting claims under 35 U.S.C. § 103, an examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

"A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1976)).

When making a determination concerning obviousness, all limitations of the claim must be evaluated. 35 U.S.C. 103, *In re Miller*, 418 F.2d 1392, 64 USPQ 46 (CCPA 1969). See also *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There must be

some logical reason apparent from the record that would justify modification of the reference.  
*In re Royal* 188 USPQ 132 (CCPA 1975).

A conclusion of obviousness must be based on more than one reference. However, in reaching this conclusion, the Examiner cannot just pick and choose only as much as will support a given position, because that would constitute impermissible hindsight. *In re Clayton*, 205 USPQ 269 (PTO Bd of App. 1979).

Moreover, a combination of references to obviate a claim is improper unless the prior art suggests the combination or modification. More specifically, before the PTO can combine the disclosure of two or more references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found in the references themselves or in the knowledge generally available to the person skilled in the art. *In re Jones* 21 USPQ2d 1941 (Fed. Cir. 1992)..

If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

## **2. Difference Between the Cited Art and Claims at Issue**

Claims that depends from claim 5, and have the following requirements as a whole:

5. A method for *making a combination of a thematic package and an article contained in the package for combined marketing*, the method including the steps of:

constructing the package as a replica of a recognizable icon, the package having a shape that is different than any shape to be contained therein,

*the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package,*

the package having a hollow interior;

locating the article within the hollow interior of the package to form the combination of the article and the thematically-shaped package; and

*marketing the combination.*

As per claim 5 discussed above and incorporated by reference, the italicized portion of the claim is different than the teaching in Gossard. The Examiner admits that none of the following are not found in Gossard.

8. *The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a golf ball as the icon, and wherein the activity is a game of golf.*

10. *The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a life preserver as the icon, and wherein the activity is a race.*

12. *The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a tennis ball as the icon, and wherein the activity is a game of tennis.*

14. *The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a wheel as the icon, and wherein the activity is a race.*

15. *The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a charge or bank card as the icon, and wherein the activity includes use of the card.*

17. *The method of claim 5, further including the step of locating a logo on the package.*

18. *The method of claim 5, further including the step of: adding an outer layer of packaging to the combination, the outer layer of packaging shaped to visually suggest the associated activity.*

23. *The method of claim 5, wherein the step of constructing includes securing to an exterior part of the package a means for attaching the package to another article.*

29. *The method of any one claims 5 and 8-23, wherein the step of constructing includes constructing the replica out of plastic and the article out of plastic.*

49. *The method of claim 5, wherein the step of constructing includes the step of imprinting a message on the package, the message being suggestive of the use of the article.*

Claim 51 and the claims that depend therefrom have the following requirements as a whole:

51. *A method for making more than one combination of a thematic package and article respectively contained therein for combined marketing, the method including the steps of:*

*constructing the packages as respective replicas of at least one recognizable*

icon, one of the packages having a shape that is different than any shape to be contained therein,

*each said package having a shape visually suggestive of an activity associated with said at least one icon in which the respective article is used during the activity, after removal from the package, and*

*each said package having a hallow interior;*

*locating the respective articles within the respective hallow interiors of the respective packages to form the more than one combination of the articles and the thematic packages; and*

*marketing the more than one combination.*

As per claim 5 discussed above and incorporated by reference, the italicized portion of the claim is different from the teaching in Gossard. The Examiner admits that none of the following are not found in Gossard.

53. *The method of claim 51, wherein the step of marketing the more than one combination is carried out with the respective packages resembling balls and with a box therefore.*

55. *The method of claim 51, wherein the step of locating is carried out with the articles respectively being different kinds of articles.*

57. *The method of claim 51, wherein the step of constructing the packages includes constructing the packages to respectively resemble a variety of balls.*

### **3. When viewed as a whole, the cited art fails to disclose the claimed subject matter**

Two or more references can be combined to obviate a claim only if they can be combined to teach all the claimed elements. Each of the claims rejected under Sec. 103 have one or more elements not found in any of the art cited by the Examiner, as discussed with regard to claim 5 and incorporated by reference here, and as discussed below with regard to the additional cited art. The elements shown in *italic* portions of the independent claims are not shown in any cited art, and thus there can be no statutory obviousness.

That is, the Examiner has premised the obviousness rejections on the mistaking

belief that the italicized portions of the independent claims are shown in Gossard, when in fact they are not, as demonstrated above with regard to claim 5. The Examiner has added art to Gossard in the incorrect assumption that the italicized portions of the independent claims have been shown, and as a consequence, the Examiner did not make out a case of *prima facie* obviousness under the requirements of 35 U.S.C. Sec. 103.

**1. Claim 8**

**i. Overview**

Claim 8 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 8 is obvious over Gossard alone.

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 8 requirement of constructing the package as the replica of a golf ball as the icon, and wherein the activity is a game of golf, the Examiner contends that "While... there is no specific disclosure to making the package in the shape of a golf ball... it would have been an obvious matter of design choice...."

The Examiner also contended that although there is no disclosure of the claimed shapes, substitution would be a matter of design choice "since applicant has failed to disclose that the limitation solves any stated problem" (Office Action at page 7)

In response, the contention is respectfully traversed. The rejection is defective because the cited art does not teach or suggest all claim requirements. See the discussion of claim 5 incorporated here by reference. Additionally, the Examiner's proposed reason to modify is improper.

Applicant drew the attention of the Examiner to the specification at pages 2, line 19-page 3, line 6, in view of page 3, line 30-page page 6, line 10, etc., wherein there is a discussion of how the limitation solves a stated problem.

In response, at page 11, paragraph 32 of the Final Rejection, the Examiner states: "The 103 rejection merely applies the well established case law that a mere change in shape is well known."

Now on appeal, the contention is traversed respectfully. All inventions involve changing the shape of something, yet not every change is obvious. MPEP Sec. 2143 provides:

"There mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

The Examiner's motivation that "The 103 rejection merely applies the well established case law that a mere change in shape is well known," is not a proper reason to modify the cited art to reach the conclusion of obviousness of the claim as a whole. "It is error to reconstruct the patentee's claim as a 'blueprint,'" according to Interconnect Planning Corp. v. Feil, 774 F.2d 1132,, 227 USPQ 543 (Fed. Cir. 1985). Applicant's patent application is the only reason to modify the cited art, and this is improper. For this reason, in concert with the other inadequacies of the rejection set out regarding claim 5, the Examiner has not made out a case of *prima facie* obviousness.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been

recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia while engaged in the activity (activity is a game of golf) somehow using the photograph after it is removed from the packaging made in some combination for marketing. The Examiner's contradictory, if not preposterous, claim interpretations notwithstanding, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

## **2. Claim 10**

### **i. Overview**

Claim 10 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 10 is obvious over Gossard alone.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 10 requirement of constructing the package as the replica of a life preserver as the icon, and wherein the activity is a race, the



Examiner contends that "While... there is no specific disclosure to making the package in the shape of a... life preserver... it would have been an obvious matter of design choice...." The Examiner also contended that although there is no disclosure of the claimed shapes, substitution would be a matter of design choice "since applicant has failed to disclose that the limitation solves any stated problem" (Office Action at page 7)

In response, the contention is respectfully traversed. The rejection is defective because the cited art does not teach or suggest all claim requirements. See the discussion of claim 5 incorporated here by reference. Additionally, the Examiner's proposed reason to modify is improper.

However, Applicant drew the attention of the Examiner to the specification at pages 2, line 19-page 3, line 6, in view of page 3, line 30-page page 6, line 10, etc., wherein there is a discussion of how the limitation solves a stated problem.

In response, at page 11, paragraph 32 of the Final Rejection, the Examiner states: "The 103 rejection merely applies the well established case law that a mere change in shape is well known."

Now on appeal, the contention is traversed respectfully. All inventions involve changing the shape of something, yet not every change is obvious. MPEP Sec. 2143 provides:

"There mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

The Examiner's motivation that "The 103 rejection merely applies the well established case law that a mere change in shape is well known," is not a proper reason to modify the cited art to reach the conclusion of obviousness of the claim as a whole. "It is error to reconstruct the patentee's claim as a 'blueprint,'" according to Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Applicant's patent application is the only reason to modify the

cited art, and this is improper. For this reason, in concert with the other inadequacies of the rejection set out regarding claim 5, the Examiner has not made out a case of *prima facie* obviousness.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, it would seem that the Examiner is suggesting that Gossard teaches a life preserver (Gossard does not mention a life preserver, nor is it clear how Gossard's ball could be modified into a life preserver) suggestive of collecting sports memorabilia with a replica of while engaged in the activity (wherein the activity is a race) somehow using the photograph after it is removed from the packaging made in some combination for the marketing step. The Examiner's contradictory, if not preposterous, claim interpretations notwithstanding, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of

obviousness has not been made out based on Gossard alone.

### **3. Claim 12**

#### **i. Overview**

Claim 12 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 12 is obvious over Gossard alone.

#### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 12 requirement of wherein the step of constructing includes: constructing the package as the replica of a tennis ball as the icon, and wherein the activity is a game of tennis, the Examiner contends that "While... there is no specific disclosure to making the package in the shape of a... tennis ball... it would have been an obvious matter of design choice...." The Examiner also contended that although there is no disclosure of the claimed shapes, substitution would be a matter of design choice "since applicant has failed to disclose that the limitation solves any stated problem" (Office Action at page 7)

In response, the contention is respectfully traversed. The rejection is defective because the cited art does not teach or suggest all claim requirements. See the discussion of claim 5 incorporated here by reference. Additionally, the Examiner's proposed reason to modify is improper.

However, Applicant drew the attention of the Examiner to the specification at pages 2, line 19-page 3, line 6, in view of page 3, line 30-page page 6, line 10, etc., wherein there is a discussion of how the limitation solves a stated problem.

In response, at page 11, paragraph 32 of the Final Rejection, the Examiner

states: "The 103 rejection merely applies the well established case law that a mere change in shape is well known."

Now on appeal, the contention is traversed respectfully. All inventions involve changing the shape of something, yet not every change is obvious. MPEP Sec. 2143 provides:

"There mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

The Examiner's motivation that "The 103 rejection merely applies the well established case law that a mere change in shape is well known," is not a proper reason to modify the cited art to reach the conclusion of obviousness of the claim as a whole. "It is error to reconstruct the patentee's claim as a 'blueprint,'" according to Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Applicant's patent application is the only reason to modify the cited art, and this is improper. For this reason, in concert with the other inadequacies of the rejection set out regarding claim 5, the Examiner has not made out a case of *prima facie* obviousness.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a

combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia with a replica while engaged in the activity (wherein the activity is a game of tennis) somehow using the photograph after it is removed from the packaging made in some combination for marketing. The Examiner's contradictory, if not preposterous, claim interpretations notwithstanding, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

#### **4. Claim 14**

##### **i. Overview**

Claim 14 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 14 is obvious over Gossard alone.

##### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 14 requirement of wherein the step of constructing includes: constructing the package as the replica of a wheel as the icon, and wherein the activity is a race, the Examiner contends that "While... there is no specific disclosure to making the package in the shape of a... wheel... it would have been an obvious matter of design choice...." The Examiner also contended that although there is no

disclosure of the claimed shapes, substitution would be a matter of design choice “since applicant has failed to disclose that the limitation solves any stated problem” (Office Action at page 7)

In response, the contention is respectfully traversed. The rejection is defective because the cited art does not teach or suggest all claim requirements. See the discussion of claim 5 incorporated here by reference. Additionally, the Examiner’s proposed reason to modify is improper.

However, Applicant drew the attention of the Examiner to the specification at pages 2, line 19-page 3, line 6, in view of page 3, line 30-page page 6, line 10, etc., wherein there is a discussion of how the limitation solves a stated problem.

In response, at page 11, paragraph 32 of the Final Rejection, the Examiner states: “The 103 rejection merely applies the well established case law that a mere change in shape is well known.”

Now on appeal, the contention is traversed respectfully. All inventions involve changing the shape of something, yet not every change is obvious. MPEP Sec. 2143 provides:

“There mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).”

The Examiner’s motivation that “The 103 rejection merely applies the well established case law that a mere change in shape is well known,” is not a proper reason to modify the cited art to reach the conclusion of obviousness of the claim as a whole. “It is error to reconstruct the patentee’s claim as a ‘blueprint,’” according to Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Applicant’s patent application is the only reason to modify the cited art, and this is improper. For this reason, in concert with the other inadequacies of the rejection set out regarding claim 5, the Examiner has not made out a case of *prima facie*

**i. Overview**

Claim 15 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 15 is obvious over Gossard alone.

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 14 requirement of wherein the step of constructing includes: constructing the package as the replica of a charge or bank card as the icon, and wherein the activity includes use of the card, the Examiner contends that "While... there is no specific disclosure to making the package in the shape of a... card... it would have been an obvious matter of design choice...." The Examiner also contended that although there is no disclosure of the claimed shapes, substitution would be a matter of design choice "since applicant has failed to disclose that the limitation solves any stated problem" (Office Action at page 7)

In response, the contention is respectfully traversed. The rejection is defective because the cited art does not teach or suggest all claim requirements. See the discussion of claim 5 incorporated here by reference. Additionally, the Examiner's proposed reason to modify is improper.

However, Applicant drew the attention of the Examiner to the specification at pages 2, line 19-page 3, line 6, in view of page 3, line 30-page page 6, line 10, etc., wherein there is a discussion of how the limitation solves a stated problem.

In response, at page 11, paragraph 32 of the Final Rejection, the Examiner states: "The 103 rejection merely applies the well established case law that a mere change in shape is well known."

obviousness.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia with a replica (Gossard does not mention a wheel, nor is it clear how Gossard's ball could be modified into a wheel) while engaged in the activity (wherein the activity is a race) somehow using the photograph after it is removed from the packaging made in some combination for marketing. The Examiner's contradictory, if not preposterous, claim interpretations notwithstanding, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

## **5. Claim 15**



Now on appeal, the contention is traversed respectfully. All inventions involve changing the shape of something, yet not every change is obvious. MPEP Sec. 2143 provides:

"There mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

The Examiner's motivation that "The 103 rejection merely applies the well established case law that a mere change in shape is well known," is not a proper reason to modify the cited art to reach the conclusion of obviousness of the claim as a whole. "It is error to reconstruct the patentee's claim as a 'blueprint,'" according to Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Applicant's patent application is the only reason to modify the cited art, and this is improper. For this reason, in concert with the other inadequacies of the rejection set out regarding claim 5, the Examiner has not made out a case of *prima facie* obviousness.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole,

including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, it would seem that the Examiner is suggesting that Gossard teaches collecting sports memorabilia with a replica (Gossard does not mention a charge or bank card, nor is it clear how Gossard's ball could be modified into a charge or bank card) while engaged in the activity (wherein the activity includes use of the card) somehow using the photograph after it is removed from the packaging made in some combination for marketing. The Examiner's contradictory, if not preposterous, claim interpretations notwithstanding, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

## **6. Claim 18**

### **i. Overview**

Claim 18 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 18 is obvious over Gossard alone.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 18 requirement of further including the step of adding an outer layer of packaging shaped to visually suggest information about the associated activity, the Examiner contends that "While Gossard... does not specifically disclose adding an outer layer of packaging shape to visually suggest information about the associated activity. The Examiner explains that this second missing teaching in the cited art is that "it is an inherent matter of design choice to add an outer layer of

packaging to visually suggest information associated with the associated activity since this is an inherently old and well known concept in the art of packaging/marketing (i.e., adding plastic bubble enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents, and also printing the contents or various characteristics of the contents on the outside layer of packaging which in the instant case may include "Baseball shaped sports memorabilia Bank" or a similar phrase, along with the location of the manufacturer.

As a first sub-point, this is not what the claim requires. The rejection is based on a mischaracterization of the claim requirements.

As a second sub-point, at page 8 of the Office Action, the Examiner contended that a claim requirement is inherently old and well known as follows:

Gossard...does not specifically disclose adding an outer layer of packaging also shaped to visually convey information about the associated activity. It would have been an obvious matter of design choice to add an outer layer of packaging also shaped to visually convey information about the associated activity since this is an inherently old and well known concept...

In response, pursuant to 37 C.F.R. Sec. 1.104(d)(2), Applicant required a reference at page 18 of the Amendment and Response filed September 16, 2003. At page 12 of the Final Rejection, the Examiner refused and asserted:

The Examiner has personal knowledge and knows of no one that would contradict the statement...

This rejection is defective under the C.F.R. for failing to provide the required reference, and a patent cannot be withheld based on mere Examiner contention that he does not know anyone who would contradict him.

Additionally, the Examiner contends that "one may walk into any department store in the country and see that this rejection is easily met by merely browsing the aisles." Applicant's priority date is about a decade ago, and for this reason too, the Examiner's contention is not evidence of prior art obviousness.

Indeed, Judge Newman, in her opinion *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) repeats a fundamental principle of patent law:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Judge Newman went on to advise the USPTO that it cannot meet that test by simply saying that the basis comes from “common knowledge or common sense, *viz*:

The “common knowledge and common sense,” on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act... The Board’s findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency’s expertise, do not substitute for authority when the law requires authority. (*Id.* At 1344-45, USPQ2d at 1434).

For the foregoing reasons, the rejection is defective. Additionally, with regard to “design choice” rejection, the argument set out with regard to claim 15 is repeated here.

As a third sub-point, *prima facie* obviousness has not been shown because the evidence is insufficient. In addition to the inadequacies mentioned in the base claim 5, incorporated by reference here, Gossard does not teach or suggest further including the step of adding an outer layer of packaging shaped to visually suggest information about the associated activity.

More so, even if we forgive all the above discussed deficiencies, and find some reason to combine the Examiner’s personal recollections of a walk through some unspecified department store about a decade ago and come up with some reason to combine and modify, the theory of the rejection still does not work. The Examiner mentions “adding plastic bubble

enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents,” but this is not a teaching of the claimed outer layer of packaging shaped to visually suggest information about the associated activity. The Examiner also theorizes “also printing the contents or various characteristics of the contents on the outside layer of packaging which in the instant case may include “Baseball shaped sports memorabilia Bank” or a similar phrase, along with the location of the manufacturer, does not teach the claimed outer layer of packaging shaped to visually suggest information about the associated activity. In sum, even forgiving a mass of error, the theory still does not reach the claim requirements.

In sum, the Examiner has not made out a case of *prima facie* obviousness based on Gossard alone.

## **7. Claim 29**

### **i. Overview**

Claim 29 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 29 is obvious over Gossard alone.

### **ii. Critique of Examiner’s Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 29 requirement of wherein the step of constructing includes constructing the replica and the article out of plastic, the Examiner contends that “... it would have been obvious to make the replica and article out of plastic since this is a readily available, inexpensive material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice...”

In response, the contention is respectfully traversed. The rejection is defective

because the cited art does not teach or suggest all claim requirements. See the discussion of claim 5 incorporated here by reference, and the foregoing discussion of “design choice.”

Additionally, the Examiner’s proposed reason to modify is improper at least because the proposed modification of Gossard would destroy the intended purpose. Gossard states that it is a container for photographs. See title, etc. As to the claimed constructing the ... article out of plastic the Examiner’s contention is that making the photographs out of plastic is a mere design choice, but trying to make photographs out of plastic would seem to destroy the intended purpose of Gossard, or at least the Examiner has not provided evidence to suggest this modification is even possible. See *In re Gordon* where such a modification is not proper.

As to the claimed constructing the replica... out of plastic the Examiner’s contention seems to be contradicted by Gossard, which teaches an overcenter *spring* hinge 13. The Examiner’s contention is that making the spring out of plastic is a mere design choice, but trying to make the overcenter spring hinge out of plastic would seem to destroy the intended purpose of Gossard, or at least the Examiner has not provided evidence to suggest this modification is even possible. See *In re Gordon* where such a modification is not proper.

In addition, in order for obviousness to exist, conception of the principle of Appellant’s teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant’s claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a

combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

## **8. Claim 51**

### **i. Overview**

Claim 51 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 51 is obvious over Gossard alone.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). The Board is referred to the above-provided discussion of claim 5, which is incorporated by reference. These discussions are equally applicable to claim 51, and in addition, there is no teaching of the claimed more than one combination for...for combined marketing. The Board's attention is respectfully drawn to Figure 5, which shows the more than one combination for...for combined marketing.

To account for this missing teaching, the Examiner argues in paragraph 23, page 8, of the Final rejection that "it would have been obvious... since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art and for the efficiency in production."

The contention is traversed respectfully because the claim does not require mere duplication of parts of a device or efficiency in production. Rather, the claim requires producing a

different product that has multiple components in cooperation. See Figure 5. Nothing in Gossard teaches the claimed more than one combination for...for combined marketing. The only teaching of this requirement is Applicant's specification, and the sole reason for the modification is Examiner's hindsight. For the reasons in addition to those set out with regard to claim 5, there has been no showing of the claimed more than one combination for...for combined marketing or the required cooperation of elements in the claim. Viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

**9. Claim 53**

**i. Overview**

Claim 53 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 53 is obvious over Gossard alone.

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed suggested in the single reference (Gossard). The Board is referred to the above-provided discussion of claim 5, which is incorporated by reference. These discussions are equally applicable to claim 51, and in addition, there is no teaching of the claimed more than one combination for...for combined marketing, as discussed with regard to claim 51 and incorporated by reference. The Board's attention is respectfully drawn to Figure 5, which shows the more than one combination for...for combined marketing. Still in addition, there is no teaching or suggestion in Gossard of the requirement in claim 53 of marketing the more than one combination is carried out with the respective packages resembling balls and with a box therefore.



The Examiner offers no particular explanation of the rejection of claim 53, which is an improper rejection per se. But in any case, Gossard does not teach or suggest the claimed marketing the more than one combination is carried out with the respective packages resembling balls and with a box therefore. The only teaching of this requirement is Applicant's specification, and the sole reason for the modification of Gossard is Examiner's hindsight. For the reasons in addition to those set out with regard to claim 5, there has been no showing of the claimed marketing the more than one combination is carried out with the respective packages resembling balls and with a box therefore or the required cooperation of elements in the claim. Viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

#### **10. Claim 55**

##### **i. Overview**

Claim 55 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 55 is obvious over Gossard alone.

##### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). The Board is referred to the above-provided discussion of claim 5, which is incorporated by reference. These discussions are equally applicable to claim 51, and in addition, there is no teaching of the claimed more than one combination for...for combined marketing, as discussed with regard to claim 51 and incorporated by reference. The Board's attention is respectfully drawn to Figure 5, which shows the more than one combination for...for combined marketing. Still in addition, there is no teaching or suggestion in Gossard of the requirement in claim 55 wherein the step of locating is carried out

with the articles respectively being different kinds of articles.

The Examiner offers no particular explanation of the rejection of claim 55, which is an improper rejection per se. But in any case, Gossard does not teach or suggest the claimed wherein the step of locating is carried out with the articles respectively being different kinds of articles, and it is not apparent how Gossard could be modified to comply with the claim requirement without destroying its intended function of being a container for photographs. See title, etc. The only teaching of this requirement is Applicant's specification, and the sole reason for the modification of Gossard is Examiner's hindsight. For the reasons in addition to those set out with regard to claim 5 and 51, there has been no showing of the claimed wherein the step of locating is carried out with the articles respectively being different kinds of articles or the required cooperation of elements in the claim. Viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

## **11. Claim 57**

### **i. Overview**

Claim 57 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 57 is obvious over Gossard alone.

### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed or suggested in the single reference (Gossard). The Board is referred to the above-provided discussion of claim 5, which is incorporated by reference. These discussions are equally applicable to claim 51, and in addition, there is no teaching of the claimed more than one combination for...for combined marketing, as discussed with regard to claim 51 and

incorporated by reference. The Board's attention is respectfully drawn to Figure 5, which shows the more than one combination...for combined marketing. Still in addition, there is no teaching or suggestion in Gossard of the requirement in claim 57 wherein the step of constructing the packages includes constructing the packages to respectively resemble a variety of balls.

The Examiner offers no particular explanation of the rejection of claim 55, which is an improper rejection per se. But in any case, Gossard does not teach or suggest the claimed wherein the step of constructing the packages includes constructing the packages to respectively resemble a variety of balls, and no where does Gossard teach a variety of balls for combined marketing. The only teaching of this requirement is Applicant's specification, and the sole reason for the modification of Gossard is Examiner's hindsight. For the reasons in addition to those set out with regard to claim 5 and 51, there has been no showing of the claimed wherein the step of constructing the packages includes constructing the packages to respectively resemble a variety of balls or the required cooperation of elements in the claim.

Viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard alone.

### **C. Gossard in view of Francis**

The statement of law governing Sec. 103 set out in the brief under Section B is restated herein.

#### **1. Des. 346,185 (Francis)**

Francis is a design patent titled "Football Card Container." Figure 1 appears to show stripes adjacent to pointed ends of a flat topped box having the vertical silhouette of a football. On the top surface has the words CARD and FOOTBALL, and something resembling stitches of a football. There is no logo shown.

#### **2. Claim 17**

**i. Overview**

Claim 17 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 17 is obvious over Gossard in view of Des. 346,185 (Francis).

**ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed in the cited art. Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 17 requirement of further including the step of locating a logo on the package, the Examiner contends that "Francis discloses that it was notoriously well known in the art of packages to place a logo thereon..." The contention is respectfully traversed: Francis does not teach or suggest a logo, and there is no basis to modify Gossard to have a logo. Since a logo might contradict the subject matter of the photographs within Gossard (e.g., a New York Yankees logo on a Gossard baseball would contradict photographs of other team members), the Examiner has gone beyond the absence of a teaching into a modification contrary to the intent and purpose of the cited art.

Further, the Examiner contends that "it would have been obvious... to locate a logo on the Gossard package, as taught by Francis, *in order to represent what the package contains*." This argument presumes Applicant's invention—Francis also does not teach or suggest the use of a logo "in order to represent what the package contains," i.e., football cards. But logos have not been shown to represent what the package contains," and such seems implausible because, in order for a logo to function as a trademark, it cannot be merely descriptive of contents.

As to the particular claim requirements, perhaps the rejection implies a view that printing anything is printing to meet the claim requirement. This is not true, however. held that:

The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ration to actual volume, and legend indicating the ration, and in our judgment the appealed claims properly define this relationship.

Thus, *In re Miller* held that if printed matter is functionally related to the other elements of the invention, the printed matter must be considered in determining whether the claimed invention is nonobvious in view of the prior art. In the present claim, the package shape is required to be particularly visually suggestive etc. in combination with the logo to carry out the step of marketing the combination.

Additionally, the Examiner has provided no proper reason to combine the teachings of Francis and Gossard. It would seem that the combination would contradict the explicit purpose of each, i.e., a container for different and incompatible things.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard in combination with Francis.

### **3. Claim 49**

#### **i. Overview**

Claim 49 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 49 is obvious over Gossard in view of Francis.

#### **ii. Critique of Examiner's Position**

In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed in the cited art. Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 17 requirement of wherein the step of constructing includes the step of imprinting a message on the package, the message being suggestive of the use of the article, the Examiner contends that "Francis discloses that it was notoriously well known in the art of packages to... imprint a message on the package ..."

The contention is respectfully traversed: Francis does not teach or suggest such a message. The Francis message of CARD FOOTBALL is not suggestive of the use of the article. It is merely descriptive. See, e.g., 15 U.S.C. §1052 and TMEP 1209 regarding the well known distinction between suggestive and merely descriptive. Further, Francis's football stitches are not a teaching of imprinting a message on the package.

There is no suggestion in the cited art to modify Gossard to include the step of imprinting a message on the package, the message being suggestive of the use of the article.

The Examiner has gone beyond the absence of a teaching into a modification contrary to the

intent and purpose of the cited art.

Further, the Examiner contends that “it would have been obvious... to locate a logo (message?) on the Gossard package, as taught by Francis, *in order to represent what the package contains.*” This argument presumes Applicant’s invention—Francis also does not teach or suggest the use of the claimed message “in order to represent what the package contains,” i.e., football cards, as this would not meet the suggestive requirement of the claim.

As to the particular claim requirements, perhaps the rejection implies a view that printing anything is printing to meet the claim requirement. This is not true, however. *In re Miller*, 418 F.2d 1392, 64 USPQ 46 (CCPA 1969) held that:

The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ration to actual volume, and legend indicating the ration, and in our judgment the appealed claims properly define this relationship.

Thus, *In re Miller* held that if printed matter is functionally related to the other elements of the invention, the printed matter must be considered in determining whether the claimed invention is nonobvious in view of the prior art. In the present claim, the package shape is required to be particularly visually suggestive etc. in combination with the logo to carry out the step of marketing the combination.

Additionally, the Examiner has provided no proper reason to combine the teachings of Francis and Gossard. It would seem that the combination would contradict the explicit purpose of each, i.e., a container for different and incompatible things.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance

when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard in combination with Francis.

**D. Gossard in view of Francis**

The statement of law governing Sec. 103 set out in the brief under Section B is restated herein.

**1. Des. 196,679 (Shaffer)**

Shaffer is a design patent titled "Radio." Figures 2-4 refer to a carrying chain.

**2. Claim 23**

**i. Overview**

Claim 23 has been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that claim 23 is obvious over Gossard in view of Schaffer.

**ii. Critique of Examiner's Position**



In response, it is respectfully submitted that the rejection and contention are defective pursuant to Sec. 103 and *In re Fine*, because every element of the claimed invention is not disclosed in the cited art. Building on the inadequacies mentioned with regard to claim 5, to further account for the missing claim 23 requirement of securing to an exterior part of the package a means for attaching the package to another article, the Examiner contends that this is shown by Schaffer.

The reason to combine and modify is improper. The Examiner has provided no reason why one having ordinary skill in the art of Gossard (containers for photographs) would have known of the art of radios. The art of the claimed invention also has not been shown by the Examiner to encompass knowledge of radios.

Analogous art, according to CCPA and Federal Circuit Cases, is all art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology of the invention. Thus, the CCPA held in *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979):

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

As to the first decision, it is respectfully submitted that designs for radios are not within the inventors field of endeavor of the claimed combination of a thematic package and an article contained in the package... wherein the article is used during the activity after removal from the package. An exterior design is not the same as packaging.

As to the second decision, Schaffer is not reasonably pertinent to the particular problem with which the inventor was involved. See the portion of the claim quoted above. The guts of the Schaffer radio were never intended to be removed from the exterior.

*In re Horn*, 203 USPQ 969 (CCPA 1979)

For the teachings of a reference to be prior art under Section 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains. (*Id.* at 971)

The Examiner has provided no plausible reason whatsoever as to why one concerned with thematic packaging for marketing the combination would have considered designs for radios.

In addition, in order for obviousness to exist, conception of the principle of Appellant's teaching must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

The problem addressed by the method of the instant claims has not been shown to have been recognized in the prior art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious; and with no known inspiration for the design choice in combination with the packaging, the rejection is a hindsight reaction to the Applicant's claims. Recall that the shape of the object alone is not the invention—it is the claimed method for making a combination... as a whole. Thus, the greater reason that there has been no *prima facie* showing of obviousness is that there is no teaching or suggestion of the claim as a whole, including these undisclosed elements in cooperation.

See the discussion of claim 5, and further note that as per the discussion of claim 9 incorporated here too, viewing the claim requirements as a whole, the rejection is defective because the evidence does not teach or suggest the claimed method steps as a whole, and thus a *prima facie* case of obviousness has not been made out based on Gossard in combination with Shaffer.

**E. Other Issues**

**1. Patent Versus Trademark**

The Examiner has withdrawn all Sec. 112 rejections, but at page 12, the Examiner argues that this is a patent, not a trademark application.

Of course this correct, but this was not the point. The issue is whether the claims were properly rejected under Sec. 112. Applicant argued that in determining whether claim language is vague, consideration should be given to whether the language is clear based on such sources as the federal government, e.g., the Trademark Office. This kind of argument is in the nature of using a dictionary definition, other government documents or rules, or statutes. Applicant is entitled to point to any evidence to show that the language is not vague, and such evidence cannot be ignored.

**1. Reversal Versus Remand**

In the prior Decision, the Board remanded the application to the Examiner. As shown in the file history, respectfully, most of the art cited by in the remand was not "prior" to Applicant's effective filing date of November 15, 1994, almost a decade ago. The present application has had extended prosecution since it was filed February 18, 1997, including this second appeal. Applicant is entitled to a patent "unless" the USPTO proves otherwise, and this proof has not been shown in the course of two appeals. Therefore, Applicant respectfully requests the Board to reverse the rejections and allow issuance of Applicant's patent.

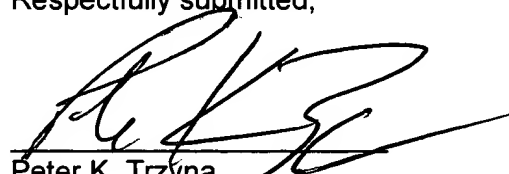
**XI. CONCLUSION**

The rejection of each of Appellant's claims pursuant to Sec. 102, and Sec. 103, is in error because Appellant's claimed method features are not shown identically, and as a whole, respectively, are not disclosed or suggested in the cited reference, except by illogical hindsight reading from one or more apparatus teachings inspired by Appellant's method steps.

Thus, for the reasons more fully set out above, all pending claims and the aforesaid groups of claims are patentable, and the rejection of them was in error with allowance being respectfully requested.

Respectfully submitted,

Date: August 2, 2004

  
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## **Appendix**

Claims 1-4 (cancelled)

5. A method for making a combination of a thematic package and an article contained in the package for combined marketing, the method including the steps of:

constructing the package as a replica of a recognizable icon, the package having a shape that is different than any shape to be contained therein,

the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package,

the package having a hollow interior;

locating the article within the hollow interior of the package to form the combination of the article and the thematically-shaped package; and

marketing the combination.

Claims 6-7 (canceled)

8. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a golf ball as the icon, and wherein the activity is a game of golf.

9. The method of claim 5, wherein the step of constructing includes: constructing the replica as a baseball as the icon, and wherein the activity is a game of baseball.

10. The method of claim 5, wherein the step of constructing includes: constructing the package as the replica of a life preserver as the icon, and wherein the activity is a

race.

11. The method of claim 5, wherein the step of constructing includes:  
constructing the package as the replica of a football as the icon, and wherein the activity is a  
game of football.

12. The method of claim 5, wherein the step of constructing includes:  
constructing the package as the replica of a tennis ball as the icon, and wherein the activity is a  
game of tennis.

13. The method of claim 5, wherein the step of constructing includes:  
constructing the package as the replica of a ball, and wherein the activity is a game in which the  
ball is used.

14. The method of claim 5, wherein the step of constructing includes:  
constructing the package as the replica of a wheel as the icon, and wherein the activity is a race.

15. The method of claim 5, wherein the step of constructing includes:  
constructing the package as the replica of a charge or bank card as the icon, and wherein the  
activity includes use of the card.

16. (canceled)

17. The method of claim 5, further including the step of locating a logo on the  
package.

18. The method of claim 5, further including the step of: adding an outer layer of packaging to the combination, the outer layer of packaging shaped to visually suggest the associated activity.

19. The method of claim 18, wherein the outer layer includes a sleeve for golf balls.

20. (previously amended) The method of claim 5, wherein the step of constructing further includes the step of:

constructing the package to have additional utility independent from containing said article.

21. The method of claim 19, wherein the step of constructing further includes the step of:

constructing the package to be a toy after said removal of said article.

22. The method of claim 20, wherein the step of constructing the package to have additional utility includes constructing the package out of a substance capable of receiving subsequent writing from a pen or magic marker.

23. The method of claim 5, wherein the step of constructing includes securing to an exterior part of the package a means for attaching the package to another article.

24. A method for making a combination of thematic packaging and an article

contained in the thematic packaging, the method including the steps of:

forming the combination by providing the article in the package,

the package being shaped like a particular ball to visually suggest a particular sport activity associated with said ball, the package being openable to remove the article,

the object being a member of the group of rain gear consisting of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat, and a seat cover,

the member being useful during the activity wherein the package is openable to remove the article for use of the object while engaged in the associated activity.

25. A method for making a combination of thematically-shaped packaging for a thematically associated article contained therein, the method including the steps of:

constructing a package having a shape that is a recognizable icon visually suggestive of an activity associated with the icon,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the package,

the article having a use in the associated activity, to form the combination of the article and the thematically-shaped packaging; and wherein the step of constructing further includes the step of:

constructing the package as a replica of a golf ball to visually suggest the activity of a game of golf; and wherein the step of locating the article within the packaging further includes the step of:

locating rain gear, as the article, within the hollow interior of the replica such that the rain gear is removable for the use during, and visually associated for use in, the activity of playing the game of golf in the rain.



26. A method of making a combination of thematically-shaped packaging and an article contained therein, the method including the steps of:

constructing the package as a replica of a symbol having a shape that visually suggests an activity associated with the symbol,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the packaging,

the article having a use in the associated activity,

to form the combination of the article and the thematically-shaped packaging;

and wherein the step of constructing further includes the step of:

constructing the package as a replica of a baseball to visually suggest the associated activity of a baseball game;

and wherein the step of locating the article within the package further includes the step of:

locating rain gear, as the article, within the packaging such that the rain gear is removable for the use during, and visually associated with, the associated activity of watching the baseball game in the rain.

27. The method of any one claims 5 and 8-23, wherein the step of locating is carried out with rain gear as the article.

28. The method of any one of claims 5 and 8-23, further including the steps of:  
locating another article within the hollow, the other article having a use during the activity, after removal from the package.

29. The method of any one claims 5 and 8-23, wherein the step of constructing

includes constructing the replica out of plastic and the article out of plastic.

30. The method of claim 5, wherein the step of constructing is carried out with the activity being a sport activity.

31. The method of claim 5, wherein the step of constructing includes constructing the package as having separably joinable pieces, the pieces being joinable to form the hollow interior of the package and being separably to open the package for the removal of the article.

49. The method of claim 5, wherein the step of constructing includes the step of imprinting a message on the package, the message being suggestive of the use of the article.

50. The method of claim 27, wherein the step of constructing includes constructing the package as having separably joinable pieces, the pieces being joinable to form the hollow interior of the package and being separably to open the package for the removal of the article.

51. A method for making more than one combination of a thematic package and article respectively contained therein for combined marketing, the method including the steps of:

constructing the packages as respective replicas of at least one recognizable icon, one of the packages having a shape that is different than any shape to be contained therein,

each said package having a shape visually suggestive of an activity associated with said at least one icon in which the respective article is used during the activity, after removal from the package, and

each said package having a hallow interior;

locating the respective articles within the respective hallow interiors of the respective packages to form the more than one combination of the articles and the thematic packages; and

marketing the more than one combination.

52. The method of claim 34, wherein:

the step of constructing the packages to replicate the at least one recognizable icon is carried out with each said at least one recognizable icon being a golf ball; and further including the step of packaging the more than one combination in a box having the appearance of a sleeve for golf balls to permit carrying out of said step of marketing the more than one combination.

53. The method of claim 34, wherein the step of marketing the more than one combination is carried out with the respective packages resembling balls and with a box therefore.

54. The method of claim 34, wherein the step of locating is carried out with the articles respectively being different kinds of rain gear.

55. The method of claim 34, wherein the step of locating is carried out with the articles respectively being different kinds of articles.

56. The method of claim 38, wherein the step of locating is carried out with one of the kinds of articles including rain gear.

57. The method of claim 34, wherein the step of constructing the packages includes constructing the packages to respectively resemble a variety of balls.

58. The method of any one claims 5 and 8-23, wherein the step of locating is carried out with the article from a group consisting of sun screen, a band-aide, a golf tee, ball mark, insect repellent, and bee sting treatment.